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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/491,527 01/26/00 BASS

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EXAMINER

ALLEN, M

ART UNIT

PAPER NUMBER

1631
DATE MAILED:

11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/491,527

Applicant(s)

BASS, JAY K.

Examiner

Marianne Allen

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 1-18 and 29-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 19-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 8.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election of Group VI, claims 19-28, in Paper No. 4 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement with respect to Groups I-V and VIII, the election has been treated as an election without traverse with respect to these groups (MPEP § 818.03(a)).

Claim 28 was inadvertently not included in any of the groups and as stated by applicant belongs to Group VI as indicated above.

Applicant's traversal with respect to Group VII, claim 29, is acknowledged. The traversal is on the ground(s) that there is no burden of search. This is not found persuasive because burden has been previously established.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's comments regarding application of prior art is noted; however, a prior art reference may be properly applied to any invention disclosed therein irrespective of a restriction requirement. That is, a restriction requirement does not limit the art that may applied except insofar as any patents issuing to one invention may not be applied against another invention that has been restricted from it.

Claims 1-18 and 29-34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b).

Claim Rejections - 35 USC § 112

Claims 21-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 21 recites a limitation with respect to the type of overlay composite generated. This appears to be a process limitation or a limitation with respect to a method. It does not clearly further define the processor in the apparatus.

Claims 22-24 recite limitations with respect to the types of image sets. This appears to be a process limitation or a limitation with respect to a method. It does not clearly further define the image capture system in the apparatus.

Claim 25 recites a limitation with respect to altering deposition of drops. This appears to be a process limitation or a limitation with respect to a method. It does not clearly further define the drop deposition system in the apparatus.

Claim 26 recites a limitation with respect to communicating the stored overlay. This appears to be a process limitation or a limitation with respect to a method. It does not clearly further define the apparatus beyond the limitations in claim 26 of a storage medium and a communication module.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 19-20, 22-24, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by McGall et al. (U.S. Patent No. 6,238,862).

McGall et al. discloses a method of testing oligonucleotide arrays made by using an apparatus comprising a drop deposition system and image capture system. A drop deposition system such as ink-jet is disclosed. (See column 4, lines 44-45, and column 5, lines 32-61). Multiple drops are used. An image capture system which can provide multiple images of the array are used and these images are used to determine efficiency of nucleotide coupling. The analysis disclosed by McGall et al. necessarily requires a processor as part of the apparatus. (See abstract, columns 6-8, columns 11-13, and claims.) This efficiency determination is deemed to meet the limitation of an overlay composite as information from at least one same location on the set of images is compared using some function. While the disclosed method compares multiple sites with each other; nevertheless, it is clear that the same site is also compared against itself to provide an overall efficiency of oligonucleotide synthesis at the feature location. With respect to claim 27, a storage medium for storage of at least the image set or overlay composite is necessarily disclosed by McGall et al. as part of the apparatus as an overall efficiency is determined and in order to determine this, the data must be stored until all information necessary for this determination has been generated.

Claims 19-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Fisher et al. (U.S. Patent No. 5,232,072).

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Fisher et al. discloses an apparatus to process an array which comprises a drop deposition system, an image capture system, and a processor. Droplet characteristics are analyzed by the processor with respect to location and size. Array errors can be identified and communicated to a remote or local user. Results can be used to correct the fabrication process. A storage medium is necessarily disclosed by Fisher et al. as being part of the apparatus in order to perform comparative analysis or correction of the process. A communication module is necessarily disclosed by Fisher et al. as being part of the apparatus in order to communicate to a remote user. See abstract, claims, and at least columns 2 and 7-8.


Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne P. Allen whose telephone number is 703-308-0666. The examiner can normally be reached on Monday-Friday, 9:00 am - 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 703-308-4028. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 for regular communications and 703-305-3014 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Marianne P. Allen
Primary Examiner
Art Unit 1631

mpa
November 5, 2001